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Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/552,586 04/19/00 KOCHMAN

M 181/01332

EXAMINER

QM12/0724

ROY ENVALL
C/O ANTHONY CASTORINA
2001 JEFFERSON DAVIS HIGHWAY
SUITE 207
ARLINGTON VA 22202

YII, I

ART UNIT

PAPER NUMBER

3764

DATE MAILED:

07/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/552,586

Applicant(s)

KOCHMAN ET AL.

Examiner

Justine Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the chain and belt couplings in claims 11, 12, 34, and 35; the radiant heat source located in the massaging element (claims 16 and 18), located within an axis of the massaging element (claim 17), in an outer portion of the massaging element (claims 19 and 20); the massaging element has an irregular surface (claims 25, 26, and 44); and the separate axes are connected in claim 41 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13, 36, and 41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled

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in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to adequately teach how to make and use the invention, i.e., fails to provide an enabling disclosure of how the at least one massaging element being motor driven using friction coupling between an axis and the motor, and how to connecte the two separate axes.

5. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2 the term “therefrom” is confusing as which part is being referred.

In claims 11 and 12, line 2 the term “the motor” lacks antecedent basis.

In claim 15, line 2 it is not clear what is meant by the term “removed”.

In claim 21, the term “a vacuum” is confusing as which structural element is referred. In addition, it is not clear which element being used to generate the vacuum.

In claim 29, the term “Teflon” is indefinite because it is a trademark.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Prehodka (Pat. No. 5,797,859).

Prehodka teaches at least one massaging element (18, 20) rotatable within a housing (12, 14), and including a heater wire 33 (radiant heat source).

8. Claims 1, 3, 5-7, 9-12, 14, 15, 31-35, 37-39, 41, 43, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Craw (Pat. No. 5,094,225).

Craw teaches a massager comprising a plurality of spherical massaging elements 46, a housing 12, heating coils 48 (radiant heat source), a motor 14, a gear 16, and a chain or belt 24. Figure 1 of Craw shows two massaging elements being mounted on a single axis (20, 28, 36, or 44), and at least two massaging elements being mounted on two separated axes (i.e., 20, 28), and the separated axes being arranged in tandem.

9. Claims 45 and 47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cheng (Pat. No. 5,336,159).

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-9, 15-20, and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch (Pat. No. 4,832,006) in view of Cheng (Pat. No. 5,336,159).

Kirsch teaches a housing 1a and a plurality of massaging rollers 3. Kirsch lacks a radiant heat source. However, Cheng teaches radiant heating sources 32 being located inside the massaging elements. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Kirsch's device with radiant heating sources as taught by Cheng, in order to enhance the massaging effect.

Regarding claim 2, the feature of choosing the radiant heat source having heat wavelength in the range of 600 nm to 1500 nm is considered as an obvious design choice within the knowledge of one skilled in the art, as is necessary and inherent upon various applications.

Regarding claims 3, 23, and 24, figure 3 of Kirsch shows the roller 3 having a wheel shaped massaging section 7 (substantially spherical in the outer circumference). Notes that features of choosing particular shaped massaging elements, i.e., spherical massaging elements or cylindrical massaging elements are considered as obvious design choices since such shaped massaging elements are notoriously old and well known in the art.

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Regarding claim 4, figure 3 of Kirsch shows the substantially cylindrical massaging element 6.

Regarding claim 6, figure 3 of Kirsch shows the massaging elements (6, 7) being mounted on a single axis.

Regarding claim 7, figure 3 of Kirsch shows the massaging elements 7 being mounted on two separated axes which being separated by a support 5.

Regarding claim 9, figure 2 of Kirsch shows two separated axes 2 being arranged in tandem.

Regrading claims 15 and 16, figure 1 of Cheng shows the separated heat sources located within the massaging elements.

Regarding claims 17-20, the feature of choosing a particular location for the heat source, i.e., located within an axis of the massaging element or in an outer portion of the massaging element is considered as an obvious design choice, since it appears that the location of the heat source is not a criticality and the modified Kirsch's device would perform equally well with the heat source located in different locations.

Regarding claim 25, figure 3 of Kirsch shows the massaging element 3 having a smooth, irregular surface.

Regarding claims 29 and 30, the feature of choosing metallic or Teflon coated massaging element is considered as an obvious design choices since metallic and Teflon coated materials are notoriously old and well known in the art.

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12. Claims 10-14 and 31-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch in view of Cheng as applied in claim 1 or 2 above, and further in view of Craw (Pat. No. 5,094,225).

Kirsch lacks a motor driven massaging element. However, Craw teaches that at least one massaging element being motor-driven. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Kirsch's device with a motor-driven system for driving at least one of the massaging elements as taught by Craw, so as to massage the body more easier.

Regarding claims 11-14, Craw teaches the motor-driven system using a chain (belt) and gear coupling for driving the massaging elements. The feature of choosing different coupling such as friction is considered as an obvious design choice for art recognized equivalents.

13. Claims 4, 13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Craw.

Regarding claim 4, Craw in figure 1 show the spherical massaging elements but lacks cylindrical massaging elements. The feature of choosing a different shape is an obvious design preference, see teaching in column 1, lines 58-62 of Craw. In addition, the cylindrical shaped massaging element is well known in the art.

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14. Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bleeker et al (Pat. No. 6,017,320) in view of Chang.

Bleeker teaches a massaging apparatus comprising rollers and a suction chamber within a housing 2. Bleeker lacks a radiant heat source. However, Cheng teaches a heat source 32 for applying heat to the tissue. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bleeker's massaging apparatus with radiant heat source as taught by Chang, so as to enhance the massaging effect.

Regarding claim 2, the feature of choosing the radiant heat source having heat wavelength in the range of 600 nm to 1500 nm is considered as an obvious design choice within the knowledge of one skilled in the art, as is necessary and inherent upon various applications.

Regarding claims 3 and 4, figure 7 of Bleeker shows the cylindrical massaging elements 37. Bleeker lacks spherical shaped massaging elements. However, the feature of choosing a different shape, i.e., the spherical shaped massaging element is considered as an obvious design choice, since it appears that Bleeker's device would perform equally well with the spherical shaped massaging elements.

Regarding claims 7 and 9, figure 2 of Bleeker shows two massaging elements (30, 31) being mounted on two separated axes and in tandem.

Regarding claim 8, figure 8 of Bleeker shows at least two massaging elements 37 being mounted on two aligned and separated axes which separated by wall extensions 90.

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Regarding claims 11-14, the feature of having the at least one massaging element being motor-driven using belt coupling, friction coupling, or gear coupling is considered as an obvious design choice, since it is a matter of design for art recognized equivalents.

Regarding claims 15-20, the location of the heat source is considered as an obvious design choice since it appears that the location of the heat source is not a criticality.

Regarding claims 21 and 22, figure 3 of Bleeker shows a vacuum pump (vacuum) 67 and a nozzle 80.

Regarding claims 25-28, the features of having irregular surface or smooth surface for the massaging elements are considered as obvious design preferences within the knowledge of one skill in the art and fails to patentably define over the prior art.

Regarding claims 28 and 29, the features of choosing metallic or Teflon coated massaging element are considered as obvious design choices since massaging elements made of metallic or Teflon coated are well known in the art.

Regarding claim 45, the modified Bleeker's device has the same structure as claimed. It would have been obvious to a skilled artisan to perform the recited steps upon seeing the modified Bleeker's device.

15. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang.

Chang does not explicitly disclose the range of the heat wavelength. However, the feature of choosing the radiant heat source having heat wavelength in the range of 600 nm to 1500 nm is

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considered as an obvious design choice within the knowledge of one skilled in the art, as is necessary and inherent upon various applications.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lang (Pat. No. 3,835,844), Jacobs (Pat. No. 5,665,053), Rogers, Jr. (Pat. No. 3,970,078), Ball (Pat. NO. 6,196,982), Guitay (Pat. No. 5,961,475), Davis (Pat. No. 927,125), Werding (Pat. NO. 3,878,837), and Cosmano (Pat. NO. 5,830,161) are cited to show different massaging devices.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justine Yu whose telephone number is (703) 308-2675. The examiner can normally be reached on Tuesday - Friday from 8:30 AM - 6:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Everett Williams whose telephone number is (703) 305-1708.

A handwritten signature in black ink, appearing to be 'JY' with a long horizontal stroke extending to the right.

Justine Yu

July 17, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.